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Carol Ann

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EXAMINER

NGUYEN, TAN D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/887,781
Filing Date: June 22, 2001
Appellant(s): ANN ET AL.

Karuna Ojanen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 25, 2010 appealing from the Office action mailed June 28, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1-2, 4, 6, 9-10, 13-19, 21-23, 26-27 and 29-30 are pending.

Claims 3, 5, 7-8, 11-12, 20, 24-25 and 28 have been canceled.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,151,582	HUANG ET AL.	11-2000
7,162,427	MYRICK ET AL.	1-2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Status

Claims 1-2, 4, 6, 9-10, 13-23, 26-27, and 29-30 are pending.

Claim 3, 5, 7-8, 11-12, 20, 24-25 and 28 have been canceled.

1. The pending claims comprise 3 groups:
 - 1) system¹: 1-2, 4, 6, 18-19, 21-23, 26-27 and 29,
 - 2) method: 9-10, 13-17, and
 - 3) system²: 30.

As of 3/30/10, Claim 1 is as followed:

1. (Currently Amended) A computer system to model a business enterprise and its information technology, comprising:

a) at least one computer processing unit;

b) at least one memory connected to at least one computer processing unit;

c) an integrated enterprise component comprising a business component as a digital representation of a business enterprise, the business component integrated and operationally linked with an information technology component, as a digital representation of an information technology infrastructure of the business enterprise, the components stored in at least one computer memory and ~~accessible by~~ executable in at least one computer processing unit;

c₁) the business component further comprising a plurality of business section components operationally integrated ~~providing one or more relationships~~ with at least one other business section component;

d) the information technology component further comprising:

d₁) at least one application software component processing to process at least business information data from the business component, and

d₂) a plurality of information technology section components operationally integrated providing with at least one other information technology section component;

e) a guiding component user interface operatively coupled to the integrated enterprise component and configured to access and change one or more of the section components;

f) an assessment component operatively coupled to the guiding component and configured to assess how a change in an impact on one section component effects the relationships with operations of others of the section components resulting from changes in one section component; and

g) an impact assessment work product generator component operatively coupled to the assessment component and configured to receive an assessment of the impact and generate a work product ~~that outputs the results of the assessment component.~~

Note: In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

2. Claims 1-2, 4, 6, 18-19, 21-23, 26-27, 29 (system), 9-10, 13-17 (method), and 30 (system) are rejected under 35 U.S.C. 103(a) as being unpatentable over MYRICK ET AL in view of HUANG et al (US 6,151,582).

As for independent claim 1 and 9, MYRICK ET AL discloses a computer system to **model a business enterprise and its information technology (business planning, transformation, delivery solutions and services)**, comprising:

{see Fig. 1, 2, 5, claim 1}

a) at least one computer processing unit;

{Fig. 20, 31, 24B, 28, 31A-31D}

b) at least one memory connected to at least one computer processing unit;

{Fig. 20, 31, 24B, 28, 31A-31D}

c) an integrated enterprise component comprising a business component as a digital representation of a business enterprise, the business component integrated and operationally linked with an information technology component, as a digital representation of an information technology infrastructure of the business enterprise, the components stored in at least one computer memory and executable in at least one computer processing unit;

c₁) the business component further comprising a plurality of business section components operationally integrated with at least one other business section component;

{see Figs. 2, 5, 10, 18, 20, col. 6, lines 10-60, cols. 10-13, col. 20, 23 “Elements, component View, Matrix, Dependencies,”, claim 1}

d) the information technology component further comprising:

d₁) at least one application software component processing to process at least business information data from the business component, and

d₂) a plurality of information technology section components operationally integrated providing with at least one other information technology section component;

e) a guiding component user interface to access and change one or more of the section components;

f) an assessment component, and

g) an impact assessment work product.

See Figs. 31B, 32, 35, Fig. 38A, “IT PLANNING”, “IT CHANGE INITIATIVES (3842)”, Fig. 38B “(3814) ASSESS DEMAND”, Fig. 39, 42A and 42B, especially 43 and 44A-44B, see abstract “impacts”, cols. 1-2, “assessing an enterprise architecture”, “model”, cols. 3-4 “current state to a new way of conducting business”, and 9 “workflow scenarios”, col. 6, lines 10-60, and

col. 37, lines 15-63, “*facilitate management of IT environment while permitting application developer the opportunity to tailor designs to meet the business demands and technology **changes**....effectively **analyze and evaluate** business and technology*

requirements.....modeling of a strategic planning process.... The IT strategic IT planning also determines the actions and parameters for the allocation of resources to meet the objectives and allows for a deliberate, planned, and effective utilization of an enterprise's investment in time and resources... ”,

and claim 1 “A method of computer **modeling** integrated business and IT frameworks and architecture in support of a business....”.

MYRICK ET AL fairly teaches the claimed invention except for explicit details on elements (e) and (f) and (g) such as assess and change one or more components and its impact.

In a similar computer system to **model a business enterprise** and its business application, **HUANG ET AL** fairly teaches a decision support system for **modeling business trend, business scenarios and determining impacts of the scenarios**, comprising:

A computer system to model a business enterprise and its information technology, comprising:

- a) at least one computer processing unit;
- b) at least one memory connected to at least one computer processing unit;
- c) an integrated enterprise component representing the business enterprise and comprising a business component integrated and operationally linked with a business sub component, the components stored in at least one computer memory and accessible by at least one computer processing unit;

d) the business component further comprising a plurality of business section operationally integrated providing one or more relationships with at least one other business section component;

d) the business sub component further comprising at least one application software component processing at least business information data from the business component, and a plurality of business section sub components operationally integrated providing one or more relationships with at least one other business sub-section component;

e) a guiding component user interface to access and change one or more of the section components;

{see Fig. 1, "**User Interface**", "**Modeling Engine Utilities**", Fig. 7, (18) "User Interface", (78) "**SCENARIOS**", (20) "**MODEL ENGINE**", Fig. 37, 41 "**What-If**" **Scenarios**", 42, }

f) an assessment component to assess how a change in one section component effects the relationships with others of the section components; and

g) an impact assessment work product generated by unit generator component to generate a work product that outputs the results of the assessment component.

{see Figs. 1, 2, 4, 34, 35, 37, 65 "ALTERNATIVE COMPONENTS", "OPTIONS", "RESULT", "FEASIBLE", "INFEASIBLE", especially **41**, and cols. 1-2,

col. 12, lines 17-50: “*when **changes in business conditions impact** one part of the supply chain, assess the **potential impact on the other parts**...Given different business scenarios...*”,

col. 13, lines 8-43: “*PSI planning...forecasts...**Evaluate the effects and ...specific changes in these plans...***”,

col. 20 “lines 30-50, “**Compute, display** (tables and graphs), and **analyze new products and model changes....**”

..91-92, “...**dynamically monitors the impact** of the user’s decisions on **the performance of the entire supply chain** by using supply chain **simulation**”, cols. 106-107 and 111-112.}

HUANG et al fairly teaches the claimed invention except for the difference in the business sub-component, i.e. an information technology (IT) component (architecture).

Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as “PHOSITA”) at the time of the invention was made to modify the business modeling teachings of MYRICK et al. to include specific scenario changes, a component and its impact on the rest of the system model as taught by HUANG et al. to allow the various decision makers to view the change from their own perspective, obtain the information and evaluate decisions and various scenarios concerning past, current and future performance (or make projections) with respect to a diverse set of often conflicting goals {see col. 1, lines 12-20, 45-67, col. 2, lines 25-45}.

Also, it would have been obvious to modify the type of sub-business component system and method of HUANG et al to (IT) component as taught by MYRICK ET AL, as

mere using other well known sub-business component that current have the same issues that requires an answer as taught in HUANG et al for determining impacts/effects of various business scenarios or decisions as a whole both currently and into the near future that support managers in making decisions {see col. 1, lines 35-42, Figs. 65-67}, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

3. Following KSR, the Supreme Court issued several rationales for supporting a conclusion that a claim would have been obvious. If a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art, and one of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) and the results would have been predictable to one of ordinary skill in the art; then the claim will be deemed obvious in view of the prior art.

As for dep. claims 2, 4 (part of 9 above) which deal with an element/item for accessing the data for changing/modifying business element, this is taught in HUANG et al /AAPA as shown in HUANG et al Figs. . 1, 2, 4, 34, 35, 37, especially **41**, and cols. 1-2, 91-92, "...*dynamically **monitors the impact** of the user's decisions on **the performance of the entire supply chain** by using supply chain **simulation***", cols. 106-107 and 111-112.}

As for dep. claims 6, 18-23, 26-27, 29, which deal with architecture (organization structures) parameters for the business enterprise and the information technology, these are fairly taught in Figs. 1, 2 of MYRICK ET AL and HUANG et al Figs. 2, -4, 7, 9.

34-35, 41 and cols. 1-2 and 91-92. Moreover, these terms or structures appear to be non-functional in a data processing system.

As for independent claims 9 and system claim 30, which appear to be the method claim and system claim to carry out the independent article claim 1 above, they are rejected over the article/computer program product claim of HUANG et al / as shown on Figs. 1-2, and 41 of HUANG et al. .

As for dep. claims 10 and 13-17 (part of 9 above), which appear to have the same limitations as in dep. claims 2, 4, 6, 18-23 and 26 (part of 1 above), they are rejected for the same reasons set forth above.

Response to Arguments

4. Applicant's arguments with respect to the previous rejections on 3/30/2010 have been considered but are not persuasive for the following reasons:

5. 1) Applicant's major arguments that MYRICK ET AL lacks an computer processing system or not a computer-implemented in view of claim 1 of MYRICK ET AL on col. 38 which discusses the use of a computer. As for the argument of assessment of changes and its impact, these are taught in cols. 1, and 37 of MYRICK ET AL.

6. 2) Applicant's major arguments that HUANG ET AL does not teach the impact of changes on a computer system, these are not found persuasive in view of the teachings in HUANG ET AL as shown in Figs. . 1, 2, 4, 34, 35, 37, especially **41**, and cols. 1-2, 91-92, "...dynamically **monitors the impact** of the user's decisions on **the performance of**

the entire supply chain by using supply chain simulation", cols. 106-107 and 111-112.} .

3) In response to applicant's argument that HUANG ET AL is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the specific business application in HUANG ET AL, supply chain management, is not essential to the scope of the claim which is modeling business decision and determining impacts as shown in cols. 1-2 and Figs. 7 and the use of teachings of HUANG ET AL for other business issue such as IT components as taught in MYRICK ET AL is within the skill of the artisan.

(10) Response to Argument

1) Appellant's major arguments that MYRICK ET AL/HUANG et al. on pages 12-13 that the combination of MYRICK et al./HUANG et al. fail to teach the claimed invention and /or the combination fail to teach the claimed invention, they are not persuasive because the combination of MYRICK et al./HUANG et al. do teach the claimed invention as shown above (to avoid duplicate citation).

2) Appellant's arguments that HUANG ET AL does not teach the impact of changes on a computer system, these are not found persuasive in view of the teachings in HUANG ET AL as shown in Figs. . 1, 2, 4, 34, 35, 37, especially **41**, and cols. 1-2, 91-92, "...*dynamically **monitors the impact** of the user's decisions on **the performance of the entire supply chain** by using supply chain **simulation***", cols. 106-107 and 111-112.} .

3) In response to appellant's argument that HUANG ET AL is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the specific business application in HUANG ET AL, supply chain management, is not essential to the scope of the claim which is modeling business decision and determining impacts as shown in cols. 1-2 and Figs. 7 and the use of general teachings (various business scenarios) of HUANG ET AL for other business

issue such as IT components as taught in MYRICK ET AL is within the skill of the artisan.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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